

REMARKS

Applicants acknowledge receipt of an Office Action dated April 24, 2006. In this response Applicants have amended claims 1-6 to correct certain minor informalities. These amendments do not narrow the scope of any of claims 1-6. Following entry of these amendments, claims 1-11 are pending in the application. Claims 6-11 have been withdrawn from consideration as being drawn to a non-elected species/invention. Accordingly, claims 1-6 are currently pending and under consideration.

In response to the PTO's restriction requirement, Applicants noted that, to the extent that (1) upon allowance of claims to the elected compositions, Applicants should be entitled to article of manufacture claims that include the subject matter of the allowed claims; and (2) upon any rejection of the elected claims, the PTO should also consider the claims of Group II, to the extent that the cited prior art shows that "the species are [not] patentably distinct." Further, Applicants noted that they would be entitled to rejoinder of method claims (Group III) in accordance with the practice of MPEP 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed.Cir. 1995).

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and the remarks which follow.

Drawing Objections

On page 2 of the Office Action, the PTO objected Figure 4, noting that reference numbers 12 and 13 not mentioned in the description. In this response, Applicants have amended the specification to recite that the "friction tester also includes a load cell 12 and a torque detection device 13." This amendment is supported, *inter alia*, at lines 30-31 on page 10 of the disclosure of Japanese Patent Application JP2002-303000 which was incorporated by reference at page 24, lines 27-28 of the present application. In view of this amendment, Applicants submit that the outstanding objection to the drawings is now moot.

Objections to the Specification

On page 3 of the Office Action, the PTO objected to the title of the invention as allegedly not being descriptive. In addition, on page 3 of the Office Action, the PTO objected the specification because of alleged informalities.

In this response, Applicants have amended the title to refer to the claimed fluororesin as suggested by the PTO. In addition, Applicants have amended the specification at pages 1, 6, 8, and 16 to address the issues raised by the PTO.

In view of the foregoing amendments, Applicants respectfully submit that the outstanding objections to the specification are now moot.

Claim Objections

On page 4 of the Office Action, the PTO objected claims 1-6 because of alleged informalities.

In this response, Applicants have amended claims 1-6 to correct the alleged informalities in a manner consistent with the PTO's suggestions. Applicants note that these amendments do not narrow the scope of any of claims 1-6.

In view of the foregoing amendments, Applicants submit that the outstanding claim objections are now moot.

Rejections under 35 U.S.C. § 112

On pages 4 and 5 of the Office Action, the PTO rejected claims 1-6 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

In this response, Applicants have amended claims 1, 5, and 6 to insert the article "a" or "an," as appropriate, in front of the terms "crosslink," "active group" and "atom." Applicants note that the use of the indefinite articles "a" and "an" encompasses both the singular and the plural. These amendments do not narrow the scope of any of claims 1-6.

With respect to the issue raised by the PTO regarding the use of the thermoplastic resin in the presence of a lubricating oil, Applicants have redrafted claim 5 to recite: "A combination of a thermoplastic resin composition with a lubricating oil-comprising: (a) a lubricating oil in contact with (b) a thermoplastic resin composition. . . .". These amendments do not narrow the scope of claim 5, *i.e.* claim 5, as amended here, remains at least as broad as claim 5 as originally presented.

Applicants submit that these amendments render claims 1-6 clear and definite within the meaning of §112. Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections under §112.

Rejections Under 35 U.S.C. § 102 - Kusano

On page 9 of the Office Action, the PTO has rejected claims 1-3 under 35 U.S.C. §102 as allegedly being anticipated by U.S. 6,465,575 to Kusano *et al.* (hereinafter “Kusano”). Applicants respectfully traverse this rejection for at least the reasons set forth below.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP §2131.

Here, Kusano fails to disclose a thermoplastic resin composition comprising “a thermoplastic resin other than a fluoro-resin” as recited in claim 1. Thus, Kusano cannot properly anticipate claim 1 or any claim depending therefrom.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under §102 based upon Kusano.

Rejection Under 35 U.S.C. §102 - Seguchi

On page 10, the PTO has rejected claims 1-4 under 35 U.S.C. §102 as allegedly being anticipated by U.S. Patent 5,985,949 to Seguchi *et al.* (hereinafter “Seguchi”). Applicants respectfully traverse this rejection for at least the reasons set forth below.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP §2131.

Here, Seguchi fails to disclose “a fluoro-resin in an amount ranging from 5 to 40 parts by weight” as recited in independent claim 1. For this reason, Applicants submit that Seguchi cannot properly anticipate claim 1 or any claim depending therefrom.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under §102 based upon Seguchi.

Rejections Under 35 U.S.C. §§ 102/103 - Kusano

On page 12, the PTO rejected claim 6 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Kusano. Applicants respectfully traverse this rejection for at least the reasons set forth below.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP §2131.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143.03.

Here, Kusano fails to disclose, teach, or suggest a resinous material comprising “a thermoplastic resin other than a fluororesin” as recited in as recited in claim 6.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under §102/§103 based upon Kusano.

Rejections Under 35 U.S.C. §103 – Seguchi/JP ‘965

On page 14 of the Office Action, the PTO has rejected claim 5 as allegedly being unpatentable over Seguchi as applied to claims 1-4, and further in view of JP 63/179965 (hereinafter “JP ‘965”). Applicants respectfully traverse this rejection for at least the reasons set forth below.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143.03.

Here, neither Seguchi nor JP ‘965, taken either individually or in combination, teach or suggest “a fluororesin in an amount ranging from 5 to 40 parts by weight” as recited in claim 5. Thus, the combination of Seguchi and JP ‘965 cannot properly render claim 5 obvious.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under §103 based upon Seguchi and JP ‘965.

Double Patenting Rejection - Ota

On page 6 of the Office Action, the PTO rejected claims 1 and 2 on the grounds of nonstatutory, obviousness-type double patenting as being unpatentable over claims 1, 2, 7, 9, 12, 14, 15, 16, and 19 of U.S. Patent 6,884,827 to Ota et al. (hereinafter “Ota”).

In this response, Applicants have amended claim 1 to recite “a thermoplastic resin other than a fluoro-resin.” In view of this amendment and the PTO’s interpretation of the phrase “the fluoro-resin” discussed in the paragraph at the top of page 7 of the Office Action, Applicants respectfully request reconsideration and withdrawal of the outstanding obviousness-type double patenting rejection.

Rejection Under 35 U.S.C. §102 - Ota

On page 11, the PTO has rejected claims 1 and 2 under 35 U.S.C. §102 as allegedly being anticipated by Ota. Applicants respectfully traverse this rejection for at least the reasons set forth below.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP §2131.

Here, Ota fails to disclose a thermoplastic resin composition comprising “a thermoplastic resin other than a fluoro-resin, in an amount ranging from 95 to 60 parts by weight” as recited in claim 1. Accordingly, Ota cannot properly anticipate claim 1 or claim 2, which depends from claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under §102 based upon Ota.

Rejection Under 35 U.S.C. § 103 - Ota

On page 8 of the Office Action, the PTO has rejected claims 1 and 2 under 35 U.S.C. § 103(a) as being obvious over Ota. Applicants respectfully traverse this rejection for the reason set forth below.

Here, Ota fails to teach or suggest a thermoplastic resin composition comprising “a thermoplastic resin other than a fluoro-resin, in an amount ranging from 95 to 60 parts by

weight” as recited in claim 1. Accordingly, Ota cannot properly render claim 1 or claim 2, which depends therefrom, obvious.


In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of claims 1 and 2 under §103 based upon Ota.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.